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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,074	02/05/2001	Hironori Kobayashi	P/3760-2	2704

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NEW YORK, NY 100368403

EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,074

Applicant(s)

KOBAYASHI, HIRONORI

Examiner

Naeem Haq

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 7, 8 and 10-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 7, 8, and 10-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3625

DETAILED ACTION***Response to Amendment***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 23, 2005 has been entered. Claims 1-4, 7, 8, and 10-29 are pending and will be considered for examination.

Claim Objections

Claim 1 is objected to because of the following informalities: This claim recites the limitation "the user tools" (emphasis added) in line 5 of the claim. There is insufficient antecedent basis for this limitation in the claim. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3625

Claims 1 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims recite the negative limitation "...information that is at least partially not available from the other electronic agent facilities..." This negative limitation lacks proper written description support in the specification.

Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This claim recites the limitation "...enabling a user to browse databases of the suppliers without directly accessing the Internet." This claim is not enabled because the Applicant's specification teaches against this limitation. The Applicant's specification clearly discloses accessing the Internet to browse a supplier's database (see specification page 6, lines 13-20; page 9, lines 13-17; page 11, lines 6-8; page 14, lines 10-15; page 17, lines 22-26).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3625

Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This claim is dependent in claim 1 and recites the negative limitation "...without an active steps being taken by the user." However, claim 1 recites the limitation "...user-selectable electronic agent facilities which can be selected by a user with the tool..." Therefore it is unclear to the Examiner how the user can select an electronic agent without taking an active step as recited in claim 17.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 7, 8, 10-16, 18-20, and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracy et al. (US Patent 5,979,757) in view of Perkowski (US 2004/0019535 A1) and further in view of Reber et al. (US Patent 6,032,195).

Referring to claims 1, 7, 8, 18-20, 23-26, and 29, Tracy teaches a system and method for effecting procurement of desired items which include products or services or information content, the system comprising: a portable, hand-held user tool, comprising a facility for reading, storing and forwarding identification indicia appearing on the desired items (Figures 2 and 5; column 4, line 1 – column 5, line 46); a central agent facility configured to communicate with a plurality of the user tools and constructed to receive from the hand-held user tools the identification indicia (column 5, line 47 – column 6, line 25); a database associated with the central agent facility that receives the

Art Unit: 3625

desired item identification information received from the hand-held user tools (column 5, line 66 – column 6, line 7); a data gathering facility associated with the central agent facility which communicates to the suppliers users requests for the desired items and receives information from the suppliers relevant thereto; and wherein the central agent facility communicates to the user tools selective information pertaining to the desired items (column 5, line 66 – column 6, line 25). Tracy does not teach that the database correlates the desired item identification information received from the hand-held user tools with corresponding supply source information for the desired items available at or from a plurality of suppliers. However, Perkowski teaches a system for retrieving information about a product using a hand-held bar code scanner wherein the item identification information (bar code) received from the hand-held is correlated with corresponding supply source information (page 4, paragraphs [0044] and [0045]; page 13, paragraphs [0130] – page 16, paragraph [0156]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Perkowski into the system of Tracy. One of ordinary skill in the art would have been motivated to do so in order to allow the consumer to communicate directly with the supplier. Tracy and Perkowski do not teach that the central agent facility includes a plurality of user-selectable electronic agent facilities which can be selected by a user with the user tool and which electronic agent facilities are operable independently of one another and capable of providing information that is at least partially not available from the other electronic agent facilities. However, Reber teaches a method and system that uses a handheld scanner to read and transmit

Art Unit: 3625

optical code information (column 3, lines 14-22) to a plurality of software agents stored in a database (Figure 1, items "14", "60", and "64"; column 4, lines 5-16, lines 60-67; column 5, lines 1-29). Reber goes on to teach that the optical code encodes navigational data such as an electronic address (i.e. URL address) (column 2, lines 58-64), and that the URL protocol supports several "agents" (i.e. ftp, Gopher, and telnet) (column 2, lines 50-57). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have the user select an agent to process the URL address. One of ordinary skill in the art would have been motivated to do so in order to allow the user to control which protocol was used to process the URL address. Moreover, the Examiner notes that the limitation "...user-selectable electronic agent facilities which can be selected by a user...operable independently...and capable of providing information that is at least partially not available from other electronic agent facilities..." is merely an intended use of the system and does not further limit the system claim. *"Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function."* *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). *"Apparatus claims cover what a device is, not what a device does."* *Hewlett-Packard Co. v Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). For this reason, this limitation is given little patentable weight in the system claim. Finally, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Reber into the invention of Tracy and Perkowski. One of ordinary skill in the art would have been motivated to do so in order to assist the user in performing various on-line activities as

Art Unit: 3625

suggested by Reber (column 7, line 60 – column 10, line 42). Finally, Tracy teaches that the tool is operable in both an on-line and off-line mode (column 3, lines 30-60).

Referring to claim 2, Reber teaches that the mode of operation for the sensor is optical or magnetic (column 2, lines 20-33, line 58 – column 3, line 36). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Reber into the invention of Tracy and Perkowski. One of ordinary skill in the art would have been motivated to do so in order to support a variety of code recognition technologies as suggested by Reber.

Referring to claim 3, Tracy teaches that the sensor is incorporated in a mobile terminal (Figures 4 and 5).

Referring to claim 4, Tracy teaches that the tool has reduced memory requirements (column 3, lines 49-54).

Referring to claim 10, the cited prior art teaches or renders obvious all the limitations of claim 1 as noted above. The cited prior art does not explicitly disclose that the electronic agent facilities are selectable by a user based on agent types. However, Reber teaches a method and system that uses a handheld scanner to read and transmit optical code information (column 3, lines 14-22) to a plurality of software agents stored in a database (Figure 1, items "14", "60", and "64"; column 4, lines 5-16, lines 60-67; column 5, lines 1-29). Reber goes on to teach that the optical code encodes navigational data such as an electronic address (i.e. URL address) (column 2, lines 58-64), and that the URL protocol supports several "agents" (i.e. ftp, Gopher, and telnet) (column 2, lines 50-57). Therefore it would have been obvious to one of ordinary skill in

Art Unit: 3625

the art, at the time the invention was made, to have the user select an agent to process the URL address. One of ordinary skill in the art would have been motivated to do so in order to allow the user to control which protocol was used to process the URL address. Moreover, the Examiner notes that this limitation is merely an intended use of the system and does not further limit the system claim. *"Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function."* *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). *"Apparatus claims cover what a device is, not what a device does."* *Hewlett-Packard Co. v Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). For this reason, this limitation is given little patentable weight in the system claim. Finally, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Reber into the invention of Tracy and Perkowski. One of ordinary skill in the art would have been motivated to do so in order to assist the user in performing various on-line activities as suggested by Reber (column 7, line 60 – column 10, line 42). Finally, Tracy teaches that the tool is operable in both an on-line and off-line mode (column 3, lines 30-60).

Referring to claims 11-15, the cited prior art teaches or renders obvious all the limitations of claim 1 as noted above. The cited prior art does not teach an e-rate facility, e-care facility, e-billing and history facility, e-logistics facility, e-search and demand/supply facility, or e-navigator facility. However, the Examiner notes that these limitations are not functionally involved in the elements of the recited system. Therefore these limitations are deemed to be nonfunctional descriptive material. The structural

Art Unit: 3625

elements of the system claim would be the same regardless of what types of agents were used. The differences between the content of the Applicant's agents and the prior art are merely subjective. Thus this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994) also see MPEP 2106. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to provide any name for the agents in the system of the cited prior art because such names (i.e. e-rate, e-care, e-logistics) do not structurally affect or relate to the elements of the claimed system and because the subjective interpretation of such information does not patentably distinguish the claimed invention.

Referring to claims 16 and 27, Tracy teaches that the customer tool comprises an e-navigator software facility which effects communication with the agent facility (column 3, line 30 – column 5, line 46).

Referring to claims 22 and 28, Tracy, Perkowski, and Reber do not explicitly disclose providing responses to requests from the user tools by communicating to users by means of a communication mode selected from a group including: e-mail, facsimile, letter and automatically triggered voice telephone messages. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate these features into the system and method of the cited prior art. The Applicant has not disclosed that these communication modes provide an advantage, are used for a particular purpose or solve a stated problem. Furthermore, one of ordinary

Art Unit: 3625

skill in the art would have expected Applicant's invention to perform equally well with the communication mode of the cited prior art because all these communication modes are capable of convey the same message. Therefore, it would have been obvious to one of ordinary skill in this art to modify the prior art to obtain the invention as specified in the claims.

Claims 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracy et al. (US Patent 5,979,757) in view of Perkowski (US 2004/0019535 A1) and Reber et al. (US Patent 6,032,195) and further in view of Jelen et al (US Patent 6,129,276).

Referring to claims 17 and 21, the cited prior does not teach automatic triggers, or a navigational facility which monitors the location of the user and provides navigational assistance to the user via the agent facility and the suppliers. However, Jelen teaches these features (column 9, line 56 – column 10, line 17). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Jelen into the system and method of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide targeted advertisement to a consumer based on the consumer's location, as taught by Jelen.

Response to Arguments

Applicant's arguments have fully considered but they are not persuasive. The Applicant has argued that Reber is a deterministic system which reads a code and finds

Art Unit: 3625

a destination that is related to that code. Thus, the Applicant argues there is nothing which is user-selectable in Reber. The Examiner respectfully disagrees. Reber teaches a method and system that uses a handheld scanner to read and transmit optical code information (column 3, lines 14-22) to a plurality of software agents stored in a database (Figure 1, items "14", "60", and "64"; column 4, lines 5-16, lines 60-67; column 5, lines 1-29). Reber goes on to teach that the optical code encodes navigational data such as an electronic address (i.e. URL address) (column 2, lines 58-64), and that the URL protocol supports several "agents" (i.e. ftp, Gopher, and telnet) (column 2, lines 50-57). Furthermore, there is nothing in Reber's disclosure that would lead one of ordinary skill in the art to conclude that the hand-held scanner, by itself, could distinguish between – let alone launch – an ftp, Gopher or telnet connection. Reber's handheld scanner is incapable of automatically determining whether a given URL address requires an ftp, Gopher or telnet connection as alleged by the Applicant.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (571)-272-6758. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (571)-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

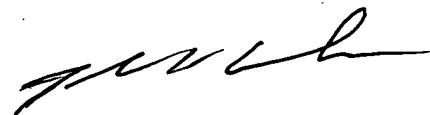
Art Unit: 3625

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Naeem Haq, Patent Examiner
Art Unit 3625

June 10, 2005



JOHN G. WEISS
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